

#56
Stm/132
2/25/03

Attorney's Docket No.: Enz-5 (D6)(C1)

IN UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Dean Engelhardt et al.)
Serial No.: 08/046,004) Group Art Unit: Not Yet Known
Filed: February 18, 1993) Previous Group Art Unit: 1803
Title: PHOSPHATE MOIETY LABELED NUCLEOTIDES) Examiner: Not Yet Known
) Prev. Exam'r: Dr. John W. Rollins

Parent Serial No. 07/532,461
Filed on May 31, 1990

May 18, 1993
New York, New York

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

ATTENTION: LICENSING AND REVIEW

**COMMUNICATION DIRECTED TO
MAY 12, 1993 ATOMIC ENERGY NOTICE**

Dear Sirs:

This Communication is directed to the Atomic Energy Notice that was mailed on May 12, 1993 (copy attached as Exhibit A) in connection with the above-identified application. A response to the May 12, 1993 Notice is due within forty-five (45) days, i.e., by June 28, 1993 (June 25, 1993 being a Saturday), at which point a formal requirement will be issued.

Applicants' undersigned attorney wishes to bring to the attention of Licensing and Review that an Atomic Energy Notice was mailed on June 15, 1990 in the predecessor parent application, Serial No. 07/532,461, filed on May 31, 1990. The instant application, Serial No. 08/046,004, was filed as a continuation application under 37 C.F.R. §1.60 ("Rule 60"). A copy of the aforementioned June 15, 1990 Notice is attached hereto as Exhibit B.

Enz-5 (D6)(C1)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	10288630138
Deposit Date	MAY 18, 1993
I hereby certify that the paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.01 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington (DC) 20231	
<i>Ronald C. Feltus</i> Ronald C. Feltus Reg. No. 32,567	MAY 18, 1993 Date

FAXED FROM ATTORNEY FOR 08/479,997
ON 2/24/03 y

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FEB 24 2003
LICENSING & REVIEW

Dean L. Engelhardt et al.

Serial No. 08/046,004

Filed: April 9, 1993

Page 2 (Communication Directed to May 12, 1993 Atomic Energy
Notice) - May 18, 1993


On July 10, 1990, Applicants' previous attorney filed a Communication in response to the June 15, 1990 Atomic Energy Notice in which he submitted five (5) separate declarations of the co-inventors named in the parent application. A copy of the July 10, 1990 Communication and the five (5) submitted declarations are attached hereto as Exhibit C.

It is the undersigned's understanding, based upon an April 6, 1993 telephone conversation with the Licensing and Review Examiner, Mr. T. H. Tubbesing (Tel. 703-308-1685), that the filing of a communication submitting a copy of the Atomic Energy Notice previously issued in the immediately preceding parent application, and also a copy of the previously filed response, should be a sufficient response to the instant Atomic Energy Notice, and that Applicants probably need not take any further action therewith.

No fee is due in connection with this Communication. If any fee or fees are due, however, The U.S. Patent and Trademark Office is hereby authorized to charge the amount of any such fee(s) to Deposit Account No. 05-1135, and to credit any overpayment thereto.

Respectfully submitted,

May 18, 1993
Date


Ronald C. Fedus
Registration No. 32,567
Attorney for Applicants

ENZO DIAGNOSTICS, INC.
c/o Enzo Biochem, Inc.
575 Fifth Avenue (18th Floor)
New York, New York 10017
(212) 856-0876

Enz-5 (D6)(C1)

Please date stamp and return to addressee.

APPLICANT: DEAN L. ENGELHARDT ET AL.	<input checked="" type="checkbox"/> Express Mail Label No. 1B288838198
TITLE: PHOSPHATE MOIETY - LABELED NUCLEOTIDES	<input type="checkbox"/> First Class Mailing Date
ENCLOSED ARE: <input type="checkbox"/> Application <input type="checkbox"/> Declaration <input type="checkbox"/> Drawings <input type="checkbox"/> Assignment <input type="checkbox"/> Response to OA <input type="checkbox"/> Amendment <input type="checkbox"/> Issue Fee <input checked="" type="checkbox"/> Other (see below)	DATE MAILED: MAY 18, 1993
<input checked="" type="checkbox"/> COMMUNICATION DIRECTED TO MAY 12, 1993	
<input type="checkbox"/> ATOMIC ENERGY NOTICE (WITH ATTACHED EXHIBITS A - C)	Serial No. 08/046,004
	Docket No. ENZ-5 (D6)(C1)

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FEB 24 2003
LICENSING & REVIEW

Please date stamp and return to addressee.

APPLICANT: DEAN L. ENGELHARDT ET AL.	<input checked="" type="checkbox"/> Express Mail Label No. 1B288838198
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<input checked="" type="checkbox"/> COMMUNICATION DIRECTED TO MAY 12, 1993	
<input type="checkbox"/> ATOMIC ENERGY NOTICE (WITH ATTACHED EXHIBITS A - C)	Serial No. 08/046,004
	Docket No. ENZ-5 (D6)(C1)

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MAY 20 1993
LICENSING & REVIEW


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/046,004	04/09/93	DEAN ENGELHARDT ET AL	ENZ-5(D6)(C1)

RONALD C. FEDUS, ESQ.
ENZO BIOCHEM, INC.
575 FIFTH AVENUE, 14TH FLOOR
NEW YORK, NY 10017

RECEIVED

MAY 17 1993

RONALD C. FEDUS

DATE MAILED: 05/12/93

EXAMINER	
ART UNIT	PAPER NUMBER
	2

**IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A
FORMAL REQUIREMENT WILL BE ISSUED**

The subject matter of this application appears to:

☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).

☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

Accordingly, no patent can issue on this application unless applicant(s) file a statement (under oath or in the form of a declaration as provided by 37 CFR 1.68) setting forth (1) the full facts concerning the circumstances under which the invention was made and conceived and (2) the relationship (if any) of the invention to the performance of any work under any contract or other arrangement with the Agency(ies) noted above. On the reverse side of this form is an example of an acceptable format for this statement. The language appearing in paragraphs III and/or IV of the example *must* appear if applicant is attempting to establish that no relationship (under item 2 above) exists.

If the invention disclosed in this application was developed under a contract, grant or cooperative agreement between the Agency indicated above and a person, small business or non-profit organization and rights to the invention have been determined by specific reference to 35 U.S.C. 202 in the contract, grant or cooperative agreement, then applicant need not submit the statement described above. Instead, applicant may file a verified statement (under oath or in the form of a declaration, 37 CFR 1.68) setting forth the information required by 35 U.S.C. 202(c)(6).

IF NO STATEMENT HAS BEEN RECEIVED WITHIN FORTY-FIVE DAYS OF THE MAIL DATE INDICATED ABOVE, a formal requirement for statement will then be issued. No provision is made for extension of the statutory thirty-day period for response to the formal requirement and the penalty for failure to file an acceptable and timely statement is abandonment of the application. Therefore, applicants are strongly encouraged to submit a statement at this time in order to avoid the issuance of a formal requirement.

IT IS IMPORTANT TO NOTE that the statement must accurately represent the property rights situation of the claimed invention if and when the application is found allowable. Thus, if during prosecution before the examiner, the claimed invention is so altered or the property rights situation so changed as to impact the accuracy of a statement submitted earlier, a supplemental statement must be filed. Failure to submit such additional information where appropriate may be considered a false representation of material facts and render the patent owner vulnerable to loss of patent rights and other sanctions as set forth in the statutes. The PTO will not review allowed applications for this possibility. The responsibility for complying with the statutes rests with the applicants.

Any questions regarding this requirement should be directed to Licensing and Review at (703) 308-3312.

**PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE
ATTENTION OF LICENSING AND REVIEW**

RECEIVED

JUN 20 1990

S. I. MOSOFF


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
07/532,461	05/31/90	DEAN L. ENGELHARDT, ET AL.	Enz-5(Div. 6)

Serle Ian Mosoff
 Enzo Biochem, Inc.
 345 Hudson Street
 New York, NY 10014

EXAMINER	
ART UNIT	PAPER NUMBER
	2

DATE MAILED: June 15, 1990

**IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A
 FORMAL REQUIREMENT WILL BE ISSUED**

The subject matter of this application appears to:

☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).

☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

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Any questions regarding this requirement should be directed to Licensing and Review at (703) 557-3011.

**PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE
 ATTENTION OF LICENSING AND REVIEW**